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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/034,415      03/04/98      MICHAUD

P      1798-7267

EXAMINER

IM52/1009

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ART UNIT

PAPER NUMBER

1743

DATE MAILED:

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10/09/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/034,415

Applicant(s)

MICHAUD, PASCAL

Examiner

LaToya I. Cross

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1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This Office Action is in response to Applicants' first amendment filed on May 30, 2001 and a supplemental amendment filed on June 29, 2001. Claims 1-4 and 6-15 are pending in the instant application. Claim 5 was cancelled by the supplemental amendment.

#### ***Withdrawal of Rejections from Previous Office Action***

The rejection of claims 1-5 under 35 USC 112, first paragraph is withdrawn in view of Applicant's amendment to delete the new matter and clarify the claimed compound.

#### ***Claim Rejections - 35 USC 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 3,957,672 to Zisman et al (hereinafter Zisman et al '672).

Applicants' claimed invention is directed to a dewetting composition consisting essentially of at least one surfactant in admixture with at least one fluorinated solvent and at least one water immiscible polyfluorinated alcohol having a specified formula.

Zisman et al '672 disclose a surface active composition for displacing aqueous or organic liquid films from solid surfaces. The surface active composition contains a

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fluorinated polyether which provides the surface activity to the composition. The composition may additionally contain fluoroalcohols and perfluoroalkane solvents. See claim 1 of Zisman et al '672. The fluoroalcohols have the formula  $F(CF_2)_mCH_2OH$ , similar to that instantly claimed by Applicants and encompassing Applicants' preferred alcohol, tridecafluorooctanol. The fluoroalcohols are present in an amount of up to 1% (col. 3, lines 10-34 and col. 7, lines 30-33). The perfluoroalkane solvents may include perfluorohexane and are present in an amount of up to 99% by volume.

Zisman et al '672 differ from the instantly claimed invention in that there is no disclosure of the composition not exhibiting a flash point. However, because the composition of Zisman et al '672 comprises similar components as claimed by Applicants, one of ordinary skill in the art would expect that they would have similar properties including flash point, absent evidence to the contrary.

Also Zisman et al '672 do not disclose the boiling point of the fluorinated solvents. However, since the reference discloses perfluoroalkane solvents (i.e. perfluorohexane), which are the same as Applicants' claimed solvents, one would expect that the boiling point would fall within the claimed range.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be obvious within the meaning of 35 USC 103 in view of the teachings of Zisman et al '672.

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3. Claims 1-3 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zisman et al '672 in view of US Patent 5,514,301 to Bil et al (hereinafter Bil et al '301).

A different embodiment of Zisman et al '301 consists of the displacement of liquids from solid surfaces for short periods of time. In this embodiment, Zisman et al '672 disclose the use of the fluorinated polyether compound as a solvent in combination with the fluoroalcohol (col. 4, lines 56-65).

This embodiment differs from the instantly claimed invention in that no surface active agent is provided.

Bil et al '301 teach compositions for dewetting solid surfaces. The compositions of Bil et al '301 comprise a surface active material prepared by the reaction of alkyl phosphoric acids, fluorinated amine and a quaternary ammonium chloride in solution with a halogenated solvent. Bil et al '301 disclose that in using such surface active agents, the deemulsification time can be reduced and in the dewetting process, separation of the aqueous phase and organic phase will be accelerated. See col. 1, lines 26-32 and col. 2, lines 1-8.

Thus, it would have been obvious to one of ordinary skill in the art to use the surface active agent described in Bil et al '301 in the dewetting compositions of Zisman et al '672 in order to allow the emulsion formed by the dewetting composition with the extracted water to better separate into two phases allowing the aqueous phase to be removed faster.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be obvious within the meaning of 35 USC 103 in view of the teachings of Zisman et al '672 and Bil et al '301.

### ***Response to Arguments***

4. Applicant's arguments filed on June 29, 2001 have been fully considered but they are not persuasive.

Applicants' concern with both rejections under 35 USC 103 involves primarily the Zisman reference. Applicants argue that Zisman is not directed to the displacement of water from solid surfaces, but rather the displacement of liquid organic substances. Applicants further argue that the prior Office Action is incorrect in stating that the fluorinated polyether in the composition of Zisman provides the surface activity.

In response, at col. 1, lines 53-57, Zisman clearly teaches that the combination of fluorinated polyether, fluoroalcohols and fluoroalkanes provides a solution capable of displacing liquid organic films and water from solid surfaces. The teachings of the reference cannot be limited by the examples shown and must be taken as a whole. Furthermore, Applicants claims do not recite any particular liquid being displaced.

Regarding the surface activity of the polyfluorinated ether of Zisman, at col. 1, lines 48-52, the reference teaches that the surface active compositions contain the specified fluorinated polyether. Since no other components (i.e. additional surfactants) are disclosed in the "surface active" compositions, one would believe that the polyethers provide such.

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Applicants state in their first remarks that their specification teaches that alkanes and ethers have flash points, therefore the presence of ethers in Zisman did not satisfy the limitation of "no flash point is exhibited". It is submitted that Applicants' specification does not point out which ethers or alkanes exhibit flash points. Applicants cannot state that the mere presence of either ethers or alkanes provides all composition with a flash point because to state such would mean that Applicants' own claimed composition, containing alkanes, would have a flash point also.

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is (703) 305-


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7360. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden, can be reached at (703) 308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

LIC  
October 9, 2001

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700